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Docket No.: PC-0022 CIP

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By: 

Printed: Katherine Stofer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Tang et al.

Title: GROWTH-RELATED INFLAMMATORY AND IMMUNE RESPONSE PROTEIN

Serial No.: 09/747,524

Filing Date: December 19, 2000

Examiner: Hill, M.

Group Art Unit: 1648

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Box Non Fee Amendment
Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL FEE SHEET

Sir:

Transmitted herewith are the following for the above-identified application:

1. Return Receipt Postcard;
2. Response to Restriction Requirement (3 pp.).

The fee has been calculated as shown below.

Claims	Claims After	-	Claims Previously	=	Present	Other Than Small Entity	Additional Fee(s)
Total	20	-	20	=	0	x \$18.00	\$ 0
Indep.	3	-	3	=	0	x \$84.00	\$ 0
First Presentation of Multiple Dependent Claims						+ \$280.00	\$ 0
Total Fee:							\$ 0

☒ No additional fee is required.☐ Please charge Deposit Account No. 09-0108 in the amount of : \$ _____

The Commissioner is hereby authorized to charge any additional fees required under 37 CFR 1.16 and 1.17, or credit overpayment to Deposit Account No. 09-0108. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

INCYTE GENOMICS, INC.

Date: April 1, 2002

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RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

Sir:

This paper is responsive to the Restriction Requirement and Request for Election dated March 13, 2002, setting a one month term for response.

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Group I (claims 1-5) drawn to an isolated cDNA.

Group II (claim 6) drawn to a method of using a cDNA to produce a protein.

Group III (claims 7-10) drawn to using cDNA to detect expression of nucleic acid.

Group IV (claims 11-12) drawn to using cDNA to screen a plurality of molecules.

Group V (claims 13-14) drawn to a purified protein or portion thereof.

Group VI (claims 15-16) drawn to a method of using a protein to screen a plurality of molecules or compounds.

Group VII (claim 17) drawn to a method of making and purifying antibodies.

Group VIII (claim 18) drawn to an antibody.

Group IX (claims 19-20) drawn to a method for using an antibody to diagnose conditions or diseases associated with expression of a protein.

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In response to the Restriction Requirement, Applicants hereby elect, with traverse, to prosecute Group I, which includes and is drawn to Claims 1-5. Applicants submit that claims 1-5 (drawn to polynucleotides encoding SEQ ID NO:1 and a vector and host cell comprising said polynucleotides for producing a polypeptide of SEQ ID NO:1) could be examined together with the claims of Group II (claim 6, drawn to the method of using the host cell of claim 5 to produce a protein), and Group V (claims 13-14, drawn to a polypeptide of SEQ ID NO:1) without undue burden. For the example, a search of the literature to determine the novelty of SEQ ID NO:1 is necessitated by claim 1 of Group I, which recites all polynucleotides encoding SEQ ID NO:1 and therefore would be found in the search for the polynucleotides of claim 1. Also, the novelty of a method of producing the polypeptide of SEQ ID NO:1 using the vector and host cell of claims 4 and 5 of Group I would overlap with the search for the novelty of these products. Applicants refer the Examiner to the MPEP § 803:

Restriction-When Proper:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP Section 802.01 Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); and
- (B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02 Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02). (Emphasis added).

While the Examiner may have properly fulfilled element (A) of this requirement in the present restriction, element (B) clearly has not. The Examiner has not presented any evidence that the examination of the claims of Groups I, II, and V, as suggested by Applicants, would pose an undue burden. Applicants therefore request that since the search of the claims of Groups I, II and V would substantially overlap, the Examiner reconsider the Restriction Requirement and examine claims 1-6 and 15-16. In the event the Examiner maintains the Restriction Requirement, Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,
INCYTE GENOMICS, INC.

Date: April 6, 2002

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